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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,390	06/29/2001	Arturo A. Rodriguez	A-7258	1010

5642 7590 06/15/2005

SCIENTIFIC-ATLANTA, INC.
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EXAMINER

LAYE, JADE O

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/896,390

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Jade O. Laye

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☒ Claim(s) 8,26,37 and 56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 822/02 1/22/02
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 2/5/02 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Claim Objections

2. Claims 8, 26, 37, and 56 are objected to because of the following informalities:
 - a. Claim 8 recites "The system of claim *prior* 6...". It should recite "The system of claim 6..."
 - b. Claim 26 recites "...the user that purchased the recordable media content," which lacks antecedent basis. There is no mention of purchasing recordable content within claims 1 or 25.
 - c. Claim 37 is missing a period.
 - d. Claim 56 recites "...the selected portable medium," which lacks antecedent basis.Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-13, 16-25, 27, 30, 32-42, 45-49, and 51-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Hassell et al. (US Pat. Pub. No. 2004/0128685).

As to claim 1, Hassell et al disclose an electronic program guide (EPG) with a program storage archive. More specifically, the system comprises a memory for storing characterization info (i.e., any info related to recordable media), a storage device for storing a plurality of portable mediums, and a user interface wherein the user can interact with the archiving system. (Abstract ; Pars. [0006-0009, 0020, 0052, & 0089]). Accordingly, Hassell et al anticipate each and every limitation of claim 1.

Claim 32 corresponds to the system claim 1. Thus, it is analyzed and rejected as previously discussed.

As to claim 2, Hassell further discloses the EPG (i.e., database record, archive, etc.) is organized in multiple fields (i.e., lists, grids, rows, etc.). (Par. [0037] & Figs. 4-14). Accordingly, Hassell et al anticipate each and every limitation of claim 2.

As to claims 3 and 4, Hassell further teaches the characterization info can be stored in the storage device and/or the portable mediums, respectively. (Pars. [0009, 0017, & 0019]). (*Note:* Storing information in the portable mediums, which are located in the storage device, is analogous to storing information in the storage device.) Accordingly, Hassell et al anticipate each and every limitation of claims 3 and 4.

Claims 46 and 47 correspond to the system claims 3 and 4, respectively. Thus, each is analyzed and rejected as previously discussed.

As to claim 5, Hassell further discloses the EPG comprises a plurality of screens. (Pars. [0020 & 0027], Figs. 4-14). Accordingly, Hassell et al anticipate each and every limitation of claim 5.

Claim 33 corresponds to the system claim 5. Thus, it is analyzed and rejected as previously discussed.

As to claim 6, Hassell further discloses the EPG is pre-configured with categories. (Figs. 5b, 7a, 7b, 13, 16, 18, & 19). Accordingly, Hassell et al anticipate each and every limitation of claim 6.

Claim 6 corresponds to the system claim 34. Thus, it is analyzed and rejected as previously discussed.

As to claim 7, Hassell further teaches the pre-configured categories can be groups corresponding to media content, genre (i.e. theme), descriptive info, and volumes (i.e., portable mediums). (Pars. [0037, 0056, & 0104]). Accordingly, Hassell et al anticipate each and every limitation of claim 7.

Claim 35 corresponds to the method claim 7. Thus, it is analyzed and rejected as previously discussed.

As to claim 8, Hassell further teaches the categories can include characterization info and the selections (i.e., programs) which correspond to said characteristics. (Pars. 0037 & 0087)). Accordingly, Hassell et al anticipate each and every limitation of claim 8.

Claims 36 and 37 correspond to the method claim 8. Thus, each is analyzed and rejected as previously discussed.

As to claim 9, Hassell further teaches the portable mediums are categorized into pre-configured default mediums corresponding to the characterizing info on the recordable content. To clarify, Hassell's "disk one" is categorized into preconfigured default volume medium one (i.e., disk one as shown in Fig. 9), which corresponds to the characterizing information listed in Figures 9 and 10. (Pars. [0056-0059]). Accordingly, Hassell et al anticipate each and every limitation of claim 9.

Claim 38 corresponds to the system claim 9. Thus, it is analyzed and rejected as previously discussed.

As to claim 10, Hassell further discloses the system displays categories (i.e., categorizes by volumes, themes, etc.) and the user selections within those categories. (Par. [0037 & 0087] & Figs. 4-14). Accordingly, Hassell et al anticipate each and every limitation of claim 10.

Claim 39 corresponds to the system claim 10. Thus, it is analyzed and rejected as previously discussed.

As to claims 11 and 12, Hassell further teaches the categories and user selections can be displayed in pre-configured and user-defined formats, respectively. (Par. [0037] & Figs. 4-14). Accordingly, Hassell et al anticipate each and every limitation of claims 11 and 12.

Claims 40 and 41 correspond to the system claims 11 and 12, respectively. Thus, each is analyzed and rejected as previously discussed.

As to claim 13, Hassell further teaches the screen can be configured to allow the user to edit categories (users can label volume/category names) and user selections within the

categories. (Pars. [0062, 0063, & 0090]). Accordingly, Hassell et al anticipate each and every limitation of claim 13.

Claim 42 corresponds to the system claim 13. Thus, it is analyzed and rejected as previously discussed.

As to claim 16, Hassell further teaches the system can comprise of personalized categories. (Par. [0057]). Accordingly, Hassell et al anticipate each and every limitation of claim 16.

Claim 45 corresponds to the system claim 16. Thus, it is analyzed and rejected as previously discussed.

As to claim 17, Hassell further teaches the user is allowed to transfer media from one storage device to another (i.e., from a device within the subscriber network). (Par. [0081]). Accordingly, Hassell et al anticipate each and every limitation of claim 17.

Claim 52 corresponds to the system claim 17. Thus, it is analyzed and rejected as previously discussed.

As to claim 18, Hassell further teaches the media can be received from a remote device external to the subscriber network. (Pars. [0016 & 0017]). Accordingly, Hassell et al anticipate each and every limitation of claim 18.

Claim 53 corresponds to the method claim 18. Thus, it is analyzed and rejected as previously discussed.

As to claims 19 and 20, Hassell further teaches the system is configured to determine if the proper portable medium is loaded and to automatically load the proper medium, respectively.

(Par. [0089]). Accordingly, Hassell et al anticipate each and every limitation of claims 19 and 20.

Claim 48 corresponds to the system claim 20. Thus, it is analyzed and rejected as previously discussed.

As to claim 21, Hassell further teaches the portable mediums can be categorized by titles. (Par. [0086, 0089, & 0090] & Figs. 7a & 13). For example, volume one can be named by the user. Thus, it would be categorized the user's personalized name. Accordingly, Hassell et al anticipate each and every limitation of claim 21.

As to claim 22, Hassell further teaches the user is allowed to enter a title, thereby prompting the system to identify the medium which corresponds to said title. (Par. [0089]). Accordingly, Hassell et al anticipate each and every limitation of claim 22.

As to claim 23, Hassell further teaches the system will prompt the user to load the proper medium. (Par. [0089]). Accordingly, Hassell et al anticipate each and every limitation of claim 23.

Claim 49 corresponds to the system claim 23. Thus, it is analyzed and rejected as previously discussed.

As to claim 24, Hassell further teaches the use of a remote. (Pars. [0019 & 0085] & Fig. 2). Accordingly, Hassell et al anticipate each and every limitation of claim 24.

Claim 54 corresponds to the system claim 24. Thus, it is analyzed and rejected as previously discussed.

As to claim 25, Hassell further teaches the recordable media and portable media can be categorized by user (i.e., dad's favorite). (Fig. 7b). Accordingly, Hassell et al anticipate each and every limitation of claim 25.

As to claim 27, Hassell further teaches the use of access locks. (Pars. [0094 & 0099]). Accordingly, Hassell et al anticipate each and every limitation of claim 27.

Claim 51 corresponds to the system claim 27. Thus, it is analyzed and rejected as previously discussed.

As to claim 30, Hassell further teaches the system can be located within the set top box. (Pars. [0017-0023]). Accordingly, Hassell et al anticipate each and every limitation of claim 30.

Claim 55 is encompassed within the limitations of claim 22. Thus, it is analyzed and rejected accordingly.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 14, 15, 28, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al in view of Browne et al. (WO 92/22983).

Claim 14 recites the system of claim 5, wherein the archive screens are configured to enable the user to search for recordable media among the plurality of portable mediums in the secondary storage device. As discussed above, Hassell et al anticipate each and every limitation of claim 5, but fail to specifically recite the limitations of claim 14. However, within the same field of endeavor, Browne et al disclose a similar system in which the user is allowed to search a program archive via the entry of keywords. (Pg. 30, Ln. 5-27 & Fig. 11). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Hassell and Browne in order to provide a more efficient search engine for the program archive.

Claim 43 corresponds to the system claim 14. Thus it is analyzed and rejected as previously discussed.

Claim 15 recites the system of claim 5, wherein the archive screens are configured to enable the user to search for characterizing information corresponding to the recordable media content among the plurality of portable mediums stored in the secondary storage device. As discussed above, Hassell et al anticipate each and every limitation of claim 5, but fail to specifically recite the limitations of claim 15. However, within the same field of endeavor, Browne et al disclose a similar system in which the user is allowed to search a program archive via the entry of keywords. (Pg. 30, Ln. 5-27 & Fig. 11). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Hassell and Browne in order to provide a more efficient search engine for the program archive.

Claim 44 corresponds to the system claim 15. Thus, it is analyzed and rejected as previously discussed.

Claim 28 recites the system of claim 27, wherein the authorized access locks have corresponding icons displayed on one of a plurality of screen displays to alert the user to the requirement for authorized access. As discussed above, Hassell et al anticipate each and every limitation of claim 27, but fail to specifically recite the limitation of claim 28. However, Browne discloses the use of access lock icons in Figure 6. Therefore, the combined systems of Hassell and Browne contain all limitations of claim 28.

5. Claims 26 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al in view of Russo. (US Pat. No. 5,619,247).

Claim 26 recites the system of claim 25, wherein the processor is further configured to select the medium for receiving the downloaded recordable media content corresponding to the user that purchased the recordable media content. As discussed above, Hassell anticipates each and every limitation of claim 25, but fails to specifically recite the limitations of claim 26. However, within the same field of endeavor, Russo discloses a similar system whereby individual users have separate storage areas (i.e., mediums). (Col. 11, Ln. 17-30). Therefore, the system selects the medium (which corresponds to purchasing user) in which to download to content. Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Hassell and Russo in order to provide a system whereby individual users could be charged for their own content.

Claim 50 corresponds to the system claim 26. Thus, it is analyzed and rejected as previously discussed.

6. Claims 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al.

Claim 31 recites the system of claim 1, wherein the processor, the memory, and the storage device are located in a head end. As discussed above, Hassell et al anticipate each and every limitation of claim 1, but fail to specifically recite the limitations of claim 31. However, in view of the disclosure used to reject claim 31 (system can be located at STB), it would be an obvious design choice to locate the system at the content provider site. Moreover, the Examiner takes Official Notice that it was notoriously known in this art at the time of applicant's invention that systems can be located at the headend. Therefore, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to modify the disclosure of Hassell,

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in order to provide a system located at the head end, thereby supplying cheaper set top box to the consumer.

7. Claims 29 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al in view of Kuroda. (US Pat. No. 6,311,011).

Claim 29 recites the system of claim 1, further comprising limitations too numerous to address herein. As discussed above, Hassell et al anticipate each and every limitation of claim 1, and further teach categorizing the media content and the recordable mediums storing said content (as discussed under rejection of claim 1), but fail to specifically recite the remaining limitation of claim 56. However, within the same field of endeavor, Kuroda discloses a similar system in which the user is allowed to choose the medium to be utilized during recording. (Col. 5, Ln. 60-67 & Fig. 5). Since the user is allowed to do this, it is possible for the system to record media into a recordable medium with characterization info matching the recorded medium. For example, if user A always records cartoons on DVDs, user A could choose the DVD icon when directing the system to record cartoons. Therefore, the system would record cartoons on the "cartoon dvd" (i.e., medium with matching characterization info). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Hassell and Kuroda in order to provide a system whereby users could specify recording mediums, thereby supplying the user with more program management flexibility.

Claim 56 recites the method of claim 32, further comprising the step of receiving the downloaded portable media content in a selected portable medium. As discussed above, Hassell

et al anticipate each and every limitation of claim 32, but fail to specifically recite the limitation of claim 56. However, within the same field of endeavor, Kuroda discloses a similar system in which the user is allowed to choose the medium to be utilized during recording. (Col. 5, Ln. 60-67 & Fig. 5). Accordingly, the combined systems of Hassell and Kuroda contain all limitations of claim 56.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. LaJoie et al (US Pat. No. 5,850,218) disclose an interactive EPG with default selection control.
- b. Wachtfogel et al (WO 00/01149) disclose an archival system wherein users can have separate recording mediums.
- c. Tomita et al (US Pat. No. 6,732,372) disclose an automatic recording device.
- d. Yeun (US Pat. Pub. No. 2002/0186957) discloses a person recorder with high-capacity archive.
- e. Knudson et al (US Pat. No. 6,275,648) disclose an EPG used in recording.
- f. Young et al (US Pat. No. 5,808,608) disclose a background schedule system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner's Initials JL
June 9, 2005.


NGOC-YEN VU
PRIMARY EXAMINER